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**OFFICE OF PETITIONS**

In re Patent No. 7,906,109 :  
Menart et al. :  
Application No. 10/583,157 : LETTER REGARDING  
Issue Date: March 15, 2011 : PATENT TERM ADJUSTMENT  
Filed: June 16, 2006 :  
Atty Docket No. 33581-US-PCT :

This is a decision on the "REQUEST FOR RECONSIDERATION OF REVISED PATENT TERM ADJUSTMENT," filed May 13, 2011, requesting that the patent term adjustment determination for the above-identified patent be changed from one hundred and ninety-seven (197) days to two hundred and fifty-two (252) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by two hundred and fifty-two (252) days is **DISMISSED**.

**BACKGROUND**

On March 15, 2011, the above-identified application matured into US Patent No. 7,906,109 with a patent term adjustment of 197 days. This request for reconsideration of patent term adjustment was timely filed within two months of the issue date of the patent. See 37 C.F.R. § 1.705(d).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Patentee has indicated that this patent is subject to two terminal disclaimers.<sup>1</sup>

At issuance, Patentee was accorded 245 (299 over Three years - 54 appellate excluded - 37 overlap) days of B-delay. Patentee

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<sup>1</sup> Petition, page 2.

maintains entitlement to a period of adjustment due to the Three Year Delay by the Office, pursuant to 37 CFR § 1.703(b), of 300<sup>2</sup> days. In other words, Patentee argues that 0 days, not 54 days, should have been excluded from B-delay for time consumed by appellate review.

### RELEVANT STATUTE AND REGULATIONS

The statutory basis for calculation of "B delay" is 35 U.S.C. 154(b)(1)(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including -

- (i) any time consumed by continued examination of the application requested by the applicant under section 132(b);
- (ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or
- (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.

The implementing regulation, 37 C.F.R. § 1.702(b) provides that:

Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:

- (1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b);
- (2) Any time consumed by an interference proceeding under 35 U.S.C. 135(a);

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<sup>2</sup> As the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the B-delay period, the over three year period begins on June 24, 2009 and ends on April 18, 2010, the day before the first RCE was filed, which amounts to 299 (not 300) days. See U.S.C. § 154(b)(1)(B)(i).

- (3) Any time consumed by the imposition of a secrecy order under 35 U.S.C. 181;
- (4) Any time consumed by review by the Board of Patent Appeals and Interferences or a Federal court; or
- (5) Any delay in the processing of the application by the Office that was requested by the applicant.

### OPINION

At issue is the language "[a]ny time consumed by review by the Board of Patent Appeals and Interferences" of 37 C.F.R. § 1.702(b).

Patentee disputes the period of time excluded from B delay for appellate review. Patentee's argument has been considered, but not found persuasive. The period consumed by appellate review, whether successful or not, is excluded from the calculation of B delay. See 35 U.S.C. 154(b)(1)(B)(ii). An appeal to the Board of Patent Appeals and Interferences commences with the filing of a notice of appeal. See 35 U.S.C. 134(a). Generally, an appeal to the Board of Patent Appeals and Interferences ends with either 1) a Board decision, 2) the examiner reopening prosecution and issuing another Office action, or 3) the applicant filing a request to withdraw the appeal and reopen prosecution (e.g. the filing of a request for continued examination). In this instance the period consumed by appellate review is 54 days, beginning on February 24, 2010, the date of filing of the notice of appeal and ending on April 18, 2010, the subsequent day prior to the date on which a Request for Continued Examination was filed. Thus, B-delay is 208 (299 - 54 - 37 overlap) days.

It is noted that the Office issued a Notice of proposed rulemaking entitled *Revision of Patent Term Extension and Adjustment Provisions Relating to Appellate Review and Information Disclosure Statements*, 76 FR 18990 (April 6, 2011). To the extent that the final rule on *Revision of Patent Term Extension and Adjustment Provisions Relating to Appellate Review* revises the interpretation of appellate review applied in this decision, Patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the date of the final rule to file a request for reconsideration. No extensions of time will be granted under § 1.136.

**CONCLUSION**

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3225.

/Paul Shanoski/  
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